



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,270	05/02/2001	Palpu Pushpangadan	056859-0126	6119
22428	7590	08/09/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,270

Applicant(s)

PUSHPANGADAN ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71,72 and 76-148 is/are pending in the application.
- 4a) Of the above claim(s) 82,104-106,108-114 and 120-148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-72, 76-81, 83-104, 107, 115-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1617

DETAILED ACTION

Claims 71-72, 76-148 are pending. Claims 82, 104-106, 108-114, 120-148 are withdrawn from consideration, as they are directed to non-elected subject matter. The Amendment filed 6/24/04, cancelled claims 73-75, and amended claim 71.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71-72, 76-81, 83-100, 103, 107, 115-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (2002/0082279) in view of Tu (CN 1113773).

The instant invention is directed toward a composition comprising an herbal colorant selected from the general of the family Boraginaceae and an additive selected from essential oils/aroma isolates selected from a group of plant species.

Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier. The composition is taught as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), and jasmine are taught as essential oils with direct skin effects for use in his composition. The essential oils are further taught as moisturizing the skin. See [0003]-[0019]. The reference lacks macrotomia and preferred percent weights.

Tu teaches a cosmetic composition comprising natural plant extracts for the treatment of acne, folliculitis, dermatitis, and wrinkles. Arnebia (synonym for Macrotomia, genera of the

Art Unit: 1617

family Boraginaceae) is taught as a plant extract. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the Macrotomia taught by Tu into the composition of Schultz because of the expectation of achieving a composition that potently treats acne and because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the amounts of the active ingredients in the combined references because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 101-102 rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Tu as applied to claims 71-72, 76-81, 83-100, 103, 107, 115-119 above, and further in view of Benford (5,110,593).

Schulz and Tu are applied as discussed above. The references do not teach beeswax.

Benford teaches a composition for treating dermatitis, such as acne. Beeswax is disclosed as the carrier. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the carrier of the combined references as beeswax because a) the combined references teach a composition for treating acne and Benford teaches beeswax as a carrier for use in topical compositions for treatment of acne; and b) because of the expectation of achieving a

Art Unit: 1617

composition wherein the base is topically safe and does not further aggravate acne.

The Examiner respectfully points out a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case the intended use of the composition claims have not been afforded patentable weight.

It is further respectfully pointed out that many claims are directed to the properties of a compound. The Examiner respectfully points out that a compound and its properties are inseparable (*In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)).

Response to Arguments

Applicant argues, "The present invention discloses a composition that is not therapeutically used for treating skin diseases, such as acne, as taught by the cited references. As is clearly recited in the rejected claims, the claimed composition is a cosmetic composition. Cosmetic compositions are structurally distinct from therapeutic compositions". This argument is not persuasive.

First, the Examiner points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process

Art Unit: 1617

of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case there is NO structural distinction between the composition of the prior art and the instant invention. The prior art teaches the same composition for application to the skin, thereby performing the intended use of the instant invention.

Second, it is respectfully pointed out that during patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” In *re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the 35 U.S.C. 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim,” to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the

Art Unit: 1617

specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board’s construction of the claim limitation “restore hair growth” as requiring the hair to be returned to its original state was held to be an ** >incorrect< interpretation of the limitation. The court held that, consistent with applicant’s disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe “restore hair growth” to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.) MPEP 2111.

The Examiner respectfully points out that even if the preamble was given weight, that the definition of a cosmetic, as defined by Webster’s dictionary, is 1 : of, relating to, or making for beauty ;2 : done or made for the sake of appearance: as a : correcting defects especially of the face; 3 : visually appealing. It is respectfully pointed out that the compositions of Schultz fall within this definition.

Art Unit: 1617

Third, it is respectfully pointed out that cosmetic compositions are not structurally distinct from therapeutic compositions. The instant declaration states, "A cosmetic is defined as a 'toiletory designed to beautify the body'". This argument is not persuasive. First, Applicant has provided no reference for this definition. Second, the definition of 'cosmetic' by Webster's Dictionary, as provided by the Examiner in the above paragraph, does not define 'cosmetic' in the same fashion. It is the Examiner's contention that Applicant has misconstrued the definition of 'cosmetic' or has altered it to fit their arguments. Furthermore, Tu teaches compositions that treat acne, as cosmetic compositions.

The instant declaration states, "The invention of Schultz et al uses the essential oil as a excipient and not as a medicine, not does it use the oil as cosmaceutical ingredients". This argument is not persuasive. It is respectfully pointed out that a composition and its properties are inseparable. Thus, while a reference may not explicitly recite every property of a compound, a compound still contains all of its properties.

The instant declaration states, "The inventors wish to state very explicitly that the present invention is not intention to function as medical treatment/therapeutic medicine. The present invention was aimed at inventing and deriving herbal colors to be used a lipstick, etc". This argument is not persuasive. This argument is directed to a method of using the instant composition. It is respectfully pointed out that the instant claims are composition claims and not method of use claims.

In Summary of response to the instant declaration, it is pointed out that the intended use of a composition is not given patentable weight, and even if the intended use was given weight,

Art Unit: 1617

the definition of a cosmetic encompasses the compositions taught by Schultz et al., and a compound and its properties are inseparable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

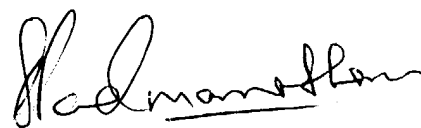
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER